

Remarks

Line 1 of claim 1 has been amended to overcome the rejection under 35 U.S.C. §112, second paragraph by providing antecedent basis for “said roof window assembly.” Claims 2-9 have been correspondingly amended.

Claims 1-11 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Moller et al. (“Moller”) in view of Sorensen et al. (“Sorensen”) and Riise. Reconsideration of this rejection is respectfully requested.

The Office Action argues that it would have been obvious to modify the skylight of Moller by adding the sliding frame of Sorensen, and then replacing the glazing disclosed by Sorensen with the screen disclosed by Riise.

The Applicants submit that, although obvious combinations of three references are not unusual, the present combination involves modifying a modifying reference which is strong evidence of unobviousness. More specifically, the present combination involves modifying a first reference in view of a second reference, but not in view of what the second reference itself discloses to the public. Instead, the second reference is modified in view of a third reference in order for the combination to arrive at all of the structure claimed by the Applicants. Furthermore, even the individual steps in rationale of making this combination would have been unobvious.

Sorensen relates to a sliding roof (14) including a roof panel (16) (glazing) provided with a girder (15) with channels for receiving supporting wheels (19) that are rotatably journaled on a wheel mounting (20) which in turn is mounted on the rim (12) of the skylight opening (13) in roof (11) (col. 2, lines 24-43).

There is no teaching or suggestion for modifying the fixed skylight assembly of Moller

with the retractable roof of Sorrensen.

Moreover, there is no further motivation to replace the glazing of the retractable roof of Sorrensen with the screen of Riise. Contrary to the assertion in the Office Action, Riise does not disclose a screen over a glazing. As clearly shown in Fig. 4 of Riise and stated in col. 2, lines 29-30 and col. 4, lines 36-52, the screen insert (10) is latched to the door jamb (52) on one side and the edge of the sliding door itself on the other side (D). In effect, the screen is mounted adjacent the door/glazing within the sliding door tracks to “replace” the door. It is also noted that Riise discloses an internal screen, not an external screen for a skylight.

Even if the glazing/roof Sorrensen were to be replaced with a screen and then combined with the skylight window assembly of Moller in the manner proposed by the Office Action, one of ordinary skill in the art would still not arrive at the claimed invention. The combination would lead to a retractable screen over an open hole in the roof or over the curb frame for another screening device of Moller. Claims 1 and 10 are directed to an assembly with a screening device mounted on the window frame itself. To this end, claims 1 and 10 recite a second profile wall of the window frame with “at an external side thereof a transverse inwards recess extending in the longitudinal direction of the frame member.” The corresponding engagement means are provided at an end member connected to the free end of the screening accessory. This arrangement is most clearly shown in Fig. 3. None of the prior art references show an external screen mounted on the frame of a fixed skylight.

Even with the knowledge of the Applicants’ invention, it is difficult to determine how to piece together the three references to arrive at the claimed invention. However, even if it were easy to piece together the three references once the Applicants’ invention is known, that is not the test for obviousness. It is well established that the fact that references can be combined does

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not make the combination obvious. See, for example, In re Imperato 179 USPQ 730 (CCPA 1973). The references themselves must suggest the combination.

Claims 2-9 are dependent on claim 1 and claim 11 is dependent on claim 10. Each of these claims are patentable for at least the reasons discussed above. New claims 12 recites similar features to those discussed above.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**Version with markings to show changes made.**"

A Notice of Allowance with claims 1-12 is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

Respectfully submitted,

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Version With Markings To Show Changes Made

In the Claims:

1. (Amended) A roof window [component] assembly comprising:

a substantially rectangular glazing element with external and internal major surfaces, and a window frame including a top member, two side members and a bottom member, said window frame members engaging edge zones of said external major surface of the glazing element along all sides thereof, wherein

said window frame is made of profile material having substantially L-shaped cross-section comprising a first profile wall for engagement with said edge zones of said external major surface of the glazing element and a second profile wall extending generally at substantially right angles to said first profile wall,

the second profile wall of at least the side members of the window frame providing at an external side thereof a transverse inwards recess extending in the longitudinal direction of the frame member,

said roof window assembly further comprising at least one external screening accessory comprising an elongate housing extending in parallel with the top and bottom members of the frame, a screening member accommodated in said housing to be retractable therefrom by movement parallel to the side members of the frame and an end member connected with a free end of said screening member and extending throughout the width of the window frame parallel to the top and bottom members of the frame, engaging means being provided at either end of said end member for engagement with said transverse inwards recess of the second profile wall of each side of the window frame of the window component.

2. (Amended) A roof window [component] assembly as claimed in claim 1, wherein the second profile wall of the top member of the window frame provides at an external side thereof a transverse inwards recess extending in the longitudinal direction of the frame member, said housing being connected with the recess of the top member of the frame.

3. (Amended) A roof window [component] assembly as claimed in claim 1, wherein the second profile wall of the bottom member of the window frame provides at an external side thereof a transverse inwards recess extending in the longitudinal direction of the frame member.

4. (Amended) A roof window [component] assembly as claimed in claim 2, wherein the second profile wall of the member of the window frame provides at an external side thereof a transverse inwards recess extending in the longitudinal direction of the frame member, providing the frame throughout its length with the same substantially L-shaped cross-section.

5. (Amended) A roof window [component] assembly as claimed in claim 1, wherein said transverse inwards recess is provided by a relatively narrow groove-like longitudinal depression having a substantially part-cylindrical bottom section.

6. (Amended) A roof window [component] assembly as claimed in claim 1, wherein said transverse inwards recess is provided by a relatively narrow groove-like longitudinal depression having a substantially flat bottom section.

7. (Amended) A roof window [component] assembly as claimed in claim 1, wherein said transverse inwards recess is provided by a longitudinal depression having a substantially V-shaped cross-section.

8. (Amended) A roof window [component] assembly as claimed in claim 1, wherein said transverse inwards recess is formed by a wall part projecting outwardly from the second profile wall.

9. (Amended) A roof window [component] assembly as claimed in claim 1, wherein said transverse inwards recess is formed by a rib projecting outwardly from the second profile wall.